



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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FEB 11 2003

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In re Application of	:
Laure Dumoutier et al	:
Serial No.: 09/626,617	: PETITION DECISION
Filed: July 27, 2000	:
Attorney Docket No.: LUD 5664	:

This is a decision on the petition under 37 CFR 1.181, filed September 30, 2002, requesting reversal of the examiner's decision not to enter an amendment after a Final Office action.

#### BACKGROUND

A review of the file history shows that the examiner mailed a first Office action to applicants on April 20, 2001, comprising only a restriction requirement of claims 1-21. Applicants replied by electing Group I, claims 1-12, with no traverse. The examiner mailed a second Office action to applicants on July 16, 2001, in which claims 1-7 were rejected under 35 U.S.C. 112, first paragraph, as based on a non-enabling disclosure for the invention claimed. Claims 8-12 were rejected under 35 U.S.C. 112, first paragraph, as based on a non-enabling disclosure for a different reason than claims 1-7.

Applicants replied on September 28, 2001, canceling non-elected claims 13-21 and replying to each of the rejections with appropriate arguments. The examiner mailed a Final Office action to applicants on December 26, 2001, in which both previous rejections were maintained and the examiner set forth detailed responses to applicants' arguments.

Applicants submitted an amendment in response to the Final rejection in which claims 1-12 were canceled and replaced by claims 13-21. The examiner mailed an Advisory Action to applicants on April 17, 2002, denying entry of the first amendment as raising new issues for written description and enablement in claim 14. This was followed by a supplemental amendment on April 29, 2002 (Certificate of Mailing dated April 18, 2002) which corrected the added claims to claims 22-32. A Notice of Appeal was also received on April 29, 2002. A second Advisory action was mailed

to applicants on July 9, 2002, denying entry of the second amendment after Final rejection as raising new issues, not previously considered, specifically that "STAT 5 transcription factor" was not previously searched or considered nor a STAT 3 transcription factor which stimulates expression of STAT 5.

Applicants then filed a letter regarding the Advisory action and a report of a telephone interview with the examiner on July 18, 2002. The letter expressed confusion as to non-entry of the amendment. The examiner replied on July 29, 2002, indicating that the response was not being considered.

Applicants then filed this petition on September 30, 2002, requesting that the amendment filed April 18, 2002, be entered as it presents the claims in better form for appeal.. An explanation was given as to the delay in filing of this petition. No Appeal Brief has been filed to date.

## DISCUSSION

Applicants argue that the amendment filed April 18, 2002, should be entered because claim 1 has been examined and found free of the prior art twice as was newly presented claim 32 which is characterized as a species of claim 1. Also argued is that murine IL-TIF/IL-21 is within the disclosed embodiment of claim 1.

A careful comparison of claims 1-12 with new claims 22-32 shows that claim 22 combines claims 1-3 into a single claim, claims 23, 24 and 25 correspond directly to claims 4, 5 and 6, and claims 28 and 29 correspond to claims 8 and 9. Claims 26, 27, 30, 31 and 32 have no direct correlation with any of the original claims, however they are generally within the scope of original claim 1. However, the limitations in these claims were not under consideration during prosecution of the application and thus raise new issues not previously considered.

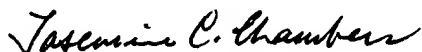
In addition, applicants' arguments that the claims have not been rejected over prior art have no bearing on whether the claims as amended raise new issues or require entry of an amendment. Here the claims have been rejected for lack of enablement - that is the specification does not enable the scope of the claims as presented. None of the claims were indicated as avoiding this rejection. Thus presentation of new claims which merely reduce the number of claims by combining them does not necessarily overcome enablement rejections. However, such amendments may place the claims in better form for appeal. In this instance, however the amended claims add embodiments (by applicants' own admissions in the petition argument) which were not previously under consideration. It is not clear that these additional embodiments have been or would reasonably have been expected to be considered in the prosecution of this application. Thus to add them at this late stage of prosecution is inappropriate and the examiner is within normal guidelines and considerations for denying entry of such amendments.

## DECISION

The petition is **DENIED** for the reasons set forth above.

**The amendment filed April 18, 2002, has not been and need not be entered. Applicants remain under obligation to file an Appeal Brief with the time period set under 37 CFR 1.192, or as may be extended under 37 CFR 1.136(a).**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.



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